

REMARKS

Reconsideration and re-examination is respectfully requested in view of the above amendments and below remarks.

Objections to the claims

Claim 5 was objected to for various informalities. Applicant has amended claim 5 to remove this informality and it is requested that the rejection be withdrawn. The Examiner is thanked for the careful review of the claims.

Rejections under 35 U.S.C. §102

Claims 1-6 were rejected under 35 U.S.C. §102(b) as being anticipated by Brzozowski (J. of Lightwave Technology article).

As best can be determined by the Applicant, based on the particular portions of the text referred to by the Examiner in the rejection, the Examiner is referring to the article entitled “All-Optical Analog to digital Converters, Hardlimiters, And Logic Gates” published in the Journal of Lightwave Technology, Vol. 19, No. 1 pp. 114-119.

35 U.S.C. §102(b) states:

“... A person shall be entitled to a patent unless ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, *more than one year prior to the date of application* for patent in the United States...”

Applicant's application was filed on February 8, 2002, but claims priority under 35 U.S.C. §119(e) to provisional patent 60/267,879, filed February 9, 2001. As such, the effective

filing date of Applicant's invention is February 9, 2001, which is less than a year from the date of publication of the Brzozowski reference. As such, the rejection under 35 U.S.C. §102(b) is improper and it is requested that it be withdrawn.

The Examiner has contacted Applicant's attorney and conveyed that the Examiner meant the rejection to be under 35 U.S.C. §102(a), stating that since the inventive entity and the authorship of the paper differ, that the paper is 'by another', and thus satisfies a rejection under 35 U.S.C. §102(a).

It is well known that a prima facie case is made out under 35 U.S.C. 102(a) if, within 1 year of the filing date, the invention, or an obvious variant thereof, is described in a "printed publication" whose authorship differs in any way from the inventive entity *unless it is stated within the publication itself that the publication is describing the applicant's work*. In re Katz, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

Applicant would like to bring to the attention of the Examiner the acknowledgement section of the Lightwave Technology Journal report, in which the authors acknowledge and thank Erik Johnson, the third inventor listed in the present application. By virtue of this acknowledgement, Applicant respectfully submits that the publication falls under the exception to 35 U.S.C. §102(a), and therefore submit that the paper is not 'by another.' Accordingly, for at least this reason it is respectfully submitted that the rejection be withdrawn.

It is noted by Applicant that much of the law surrounding rejections under 35 U.S.C. §102(a), and invented 'by another', include *more* authors on papers than are included in the patent application, and appear to be meant to protect the rights of individuals whose names are unjustly removed from patent applications; such is not the case in the present invention, where the patent application includes *all* of the authors of the paper, with the addition of the individual

whose help in preparing the paper is acknowledged within the printed publication itself.

Accordingly, it is respectfully submitted by the Applicant that a rejection under 35 U.S.C.

§102(a) is overcome by the evidence of record.

Conclusion

Applicants have made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Applicants' Attorney at the number listed below so that such issues may be resolved as expeditiously as possible.

For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

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Date

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